

Doc Code: AP.PRE.REQ

PTO/SB/33 (08-08)

Approved for use through 09/30/2008. OMB 0651-0031  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) 16129	
<p><i>FACSIMILE TRANSMITTED</i></p> <p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>September 26, 2008</u></p> <p>Signature <u><i>William J. Clemens</i></u></p> <p>Typed or printed name <u>William J. Clemens</u></p>		<p>Application Number 10/691,763</p> <p>Filed October 23, 2003</p> <p>First Named Inventor Clifford</p> <p>Art Unit 1791</p> <p>Examiner G. Koch</p>	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
<p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/06)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>26,855</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p>		<p><u><i>William J. Clemens</i></u> Signature</p> <p><u>William J. Clemens</u> Typed or printed name</p> <p><u>248-960-2100</u> Telephone number</p> <p><u>September 26, 2008</u> Date</p>	
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<p><input type="checkbox"/> *Total of _____ forms are submitted.</p>			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

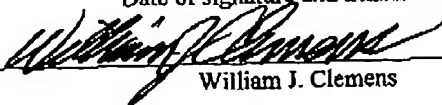
If you need assistance in completing the form, call 1-800-PTO-9189 and select option 2.

**CERTIFICATE OF FACSIMILE TRANSMISSION UNDER 37 CFR 1.8**

I hereby certify that this correspondence is being facsimile transmitted  
to the Commissioner for Patents on:

SEPTEMBER 26, 2008  
Date of signature and transmission

By

  
William J. Clemens

RECEIVED  
CENTRAL FAX CENTER  
SEP 26 2008

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: CLIFFORD, SCOTT et al. )	Confirmation No.: 6713
Serial No.: 10/691,763 )	Examiner: KOCH, GEORGE R.
Filed: October 23, 2003 )	Group Art Unit: 1791
For: <u>MODULAR PAINTING APPARATUS</u> )	<u>Attorney Docket: 16129</u>

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Honorable Sir:

Review of the above-identified application is requested for the following reasons:

1. In the Final Office Action ("FOA") dated June 30, 2008, the Examiner stated that Claims 102-151 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: They are directed towards a new robot system, and not a paint/coating applicator system. The claims can be interpreted as species, whereas species I is Claims 61-101 which represent a modular system including two guide rails, plus the generic robot and paint applicator embodiment and species II is Claims 102-151 which represent the no-waist robot, no claims as to the modular system and guide rails and generic tool embodiment. Group/species I claims elements such as a modular system with two guide rails, which is not required by group/species II. Group/species II requires no waist or a very defined 3 axis robot, which is not required by group I. No claims are generic to either species. (FOA, page 2)

2. The Examiner further stated that since applicant has received an action on the merits for the originally presented invention, this invention has been constructively

elected by original presentation for prosecution on the merits. The requirement is still deemed proper and is therefore made FINAL. (FOA, pages 2-3)

3. Claims 61, 72, 81, 90, 91, 98, 102, 115, 127 and 140 are independent claims. Claims 61-90, 94 and 95 recite a modular apparatus for painting including a paint applicator. However, Claims 91-93, 96 and 97 recite a modular apparatus for processing including process tool mounting means. Claims 98-101 recite a robot for processing including a process tool. Therefore, not all of the claims identified by the Examiner as being in species I Claims 61-101 "represent the generic robot and paint applicator embodiment".

4. Claims 102-151 recite a modular apparatus for performing a coating process including a tool for performing the coating process. Therefore, species II Claims 102-151 are directed towards "a paint/coating applicator system" and do not represent a "generic tool embodiment" as stated by the Examiner.

5. Applicant respectfully submits that Claims 102-151 are all directed to an apparatus for performing a coating process and include the elements of Claims 61-101. Applicant prepared the following chart which sets forth certain elements common to all of the claims and certain elements common to both species I and II as designated by the Examiner.

ELEMENT	SPECIES I	SPECIES II
A pair of frame rails	61, 72, 81, 90, 91, 98	102, 115, 127, 140
At least one robot arm associated with one of each of said frame rails	61, 72, 81, 90,	102, 115, 127, 140
A robot arm movable along said associated frame rail	61, 72, 81	102, 115, 127, 140
Said frame rails being elevated/located above a plane	61, 72, 81, 90, 91, 98	115, 140
Generic robot and paint applicator (as defined by Examiner)	61, 72, 81, 90	
No waist robot and generic tool (as defined by Examiner)	102, 115	

6. Note that there is no pattern to support a finding of two separate species. Neither independent Claim 91 nor independent Claim 98 of Species I recite a paint applicator. While both of these claims include a robot element, Claim 91 does not include a reference to an applicator of any form and Claim 98 includes a processing tool mounting means, but not a paint applicator. Similarly, Claims 102, 115, 127 and 140 of Species II claim a tool for performing a coating process, but neither independent Claim 127 nor independent Claim 140 of Species II recites a no waist robot.

7. All of the independent claims provide for a pair of frame rails. Both species contain claims including: at least one robot arm associated with one of each of said frame rails; a robot arm movable along said associated frame rail; and said frame rails being elevated/located above a plane.

8. Based on the above remarks, Applicant respectfully submits that all of the independent claims encompass the disclosed embodiments and overlap in scope. Therefore, the election requirement should be withdrawn.

9. The Examiner rejected Claims 61, 63, 65, 67, 69-73, 77, 79-82, 86, 87, 89-92, 94-95, and 98-101 under 35 U.S.C. 103(a) as being unpatentable over Takeo (US Patent 4,721,630) in view of Yamamoto (US Patent 5,240,745) and either or both of Nuber (DE 101 19 906 A1) and/or Pearce (US 4,781,517) (FOA, page 3) The Examiner rejected Claims 74, 83 and 97 under 35 U.S.C. 103(a) as being unpatentable over Takeo, Yamamoto, Nuber and/or Pearce, and further in view of Thome (US Patent 5,744,190). (FOA, page 9) The Examiner rejected Claims 75, 88 and 96 under 35 U.S.C. 103(a) as being unpatentable over Takeo, Yamamoto, Pearce and Thome, and further in view of Cebola (US Patent 5,738,727). (FOA, page 9) The Examiner rejected Claim 76 under 35 U.S.C. 103(a) as being unpatentable over Takeo, Yamamoto, Pearce and Thome, and further in view of Neikter (US Patent 5,296,026). (FOA, page 10) The Examiner rejected Claims 64 and 85 under 35 U.S.C. 103(a) as being unpatentable over Takeo, Yamamoto and Pearce, and further in view of Josefsson (US Patent 5,766,355). (FOA, page 11) The Examiner rejected Claims 66, and 68 under 35 U.S.C. 103(a) as being unpatentable over Takeo, Yamamoto and Pearce, and further in view of Cebola (US Patent 5,738,727). (FOA, page 11) The Examiner rejected Claims 62, 84 and 93 under

35 U.S.C. 103(a) as being unpatentable over Takeo, Yamamoto, Pearce, and further in view of Hohn et al (US Patent 4,896,274). (FOA, page 12)

10. In the following, Applicant references portions of the Amendment filed on April 19, 2008 as "(Amendment, page x)". The Examiner relies on Nuber (Nüßer DE 101 19 906 A1) as an alternative reference to support the rejection under 35 U.S.C. 103(a) of independent Claims 61, 72, 81, 90, 91, and 98 as set forth above. Nuber has a publication date after Applicant's Provisional Application Serial No. 60/420,612. Therefore, under 35 USC 102(e), Nuber is not prior art. (Amendment, page 30)

11. While Nuber and Pearce were cited as being interchangeable, the Examiner relies solely on Nuber for disclosing a paint spraying six-axis robot including a fixed frame rail, fixed cross beams and the robot having a shoulder, elbow and wrist below the auxiliary axis and racks permitting movement only in a generally vertical plane (Fig. 3). (FOA, page 5) Additionally, the Examiner relies solely on Nuber to obviate raising the frame and lowering the robot below this frame to improve access to the top surface of the substrate, and in the automobile field, improve coating of the roof of the car. (FOA, page 5) As set forth above, Nuber is not prior art and none of the independent claims in species I are obvious in view of the remaining prior art where none of the art teaches a shoulder axis below the frame rail. (Amendment, pages 30-31)


12. With regard to the claims in species II, none of the art cited by the Examiner obviates these claims either. Applicant supports this finding where: Takeo discloses a floor mounted robotic system, Yamamoto discloses a paint booth having the robot system located on the floor and the paint spray guns located alongside and overhead of the conveyor (Figure 15) and Pearce teaches a well known gantry system. (Amendment, page 31)

13. Applicant respectfully submits that independent Claims 102, 115, 127, and 140 follow the examples set forth in *In re Wakefield*, 422 F.2d 897, 899, 904, 164 USPQ 636, 638, 641 (CCPA 1970) and *In re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971) regarding negative limitations. Support for the negative limitation of no waist (Independent Claims 102 and 115) may be found in the specification at page 10, line 11. Support for the robot operating with at least three major axes (Independent Claims 127 and 140) and where the first axis is a linear axis and the second axis acts in a horizontal

plane may be found in the specification at page 5, lines 3-5, page 8, lines 6-19 and Figure 5, reference numerals 34, 36, and 40- wherein the three axes: shoulder, elbow and rail- are the controlling axis, and the wrist axis 38 is an orientation axis. (Amendment, pages 31-32)

14. Based on the above remarks, Applicant respectfully submits that all of the Claims 61-151 recite patentable subject matter.

Respectfully submitted,

  
William J. Clemens, Reg. No. 26,855  
(248) 960-2100

Fraser Clemens Martin & Miller LLC  
28366 Kensington Lane  
Perrysburg, Ohio 43551  
419-874-1100  
419-874-1130 (FAX)